

### **REMARKS**

In the final Office Action<sup>1</sup> mailed July 15, 2009, the Examiner

- (1) rejected claims 1, 3, 4, 6, and 7 under 35 U.S.C. § 103(a) as being unpatentable over Zenhausern et al. (U.S. Publication No. 2004/0011650, hereafter "Zenhausern") in view of Nikiforov et al. (U.S. Patent No. 7,060,171, hereafter "Nikiforov");
- (2) rejected claims 8-12 under 35 U.S.C. § 103(a) as being unpatentable over Zenhausern in view of Nikiforov and further in view of Lough et al. (U.S. Patent No. 5,900,481, hereafter "Lough"); and
- (3) rejected claims 8-13 under 35 U.S.C. § 103(a) as being unpatentable over Zenhausern in view of Nikiforov and further in view of Smith et al. (U.S. Patent No. 6,270,970, hereafter "Smith") and Lough.

In the Advisory Action mailed September 25, 2009, the Examiner maintained the rejections.

By this amendment, Applicant cancels claim 6, without prejudice or disclaimer, and amends claims 1 and 7. Support for the claim amendments can be found in the Specification at, for example, page 11, line 10 to page 12, line 16. Claims 1, 3, 4, and 7-13 remain pending in this application.

**I. Rejection of claims 1, 3, 4, 6, and 7 under 35 U.S.C. § 103(a) as being unpatentable over Zenhausern in view of Nikiforov**

Applicant respectfully traverses the rejection of claims 1, 3, 4, 6, and 7 under 35 U.S.C. § 103(a) as being unpatentable over Zenhausern in view of Nikiforov.

Claim 1, as amended, recites a microchip, "wherein, when the microchip is in use, the gap part is configured to block microbeads of a size greater than the sectional

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<sup>1</sup> The final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the final Office Action.

size of the gap part.” Zenhausern and Nikiforov, alone or combined, fail to teach or suggest at least the gap part.

For example, Zenhausern, at paragraph [0108], states that “[t]hese binding moieties may be immobilized . . . on a particle trapped within the [cell separation or capture] module (i.e. a bead),” (emphasis added), and at paragraph [0114], states that “binding ligands are immobilized . . . within the separation module (again, either on the internal surface of the module, on a particle such as a bead, filament or capillary trapped within the module, for example through the use of a frit),” (emphasis added).

Accordingly, Zenhausern merely discloses that binding moieties or binding ligands may be immobilized on a bead. Zenhausern does not disclose the size of the bead. Nor does Zenhausern disclose any relation between the size of the bead and the sectional size of the constriction. Moreover, Zenhausern does not disclose that the constriction may be configured to block the bead. For at least the above reasons, Zenhausern fails to teach or suggest a microchip, “wherein, when the microchip is in use, the gap part is configured to block microbeads of a size greater than the sectional size of the gap part,” as recited in amended claim 1.

Nikiforov fails to cure the deficiencies of Zenhausern. Accordingly, amended claim 1 is distinguishable over Zenhausern and Nikiforov.

Claims 3, 4, and 7 depend from claim 1 and are distinguishable over Zenhausern and Nikiforov at least due to their dependence.

Applicant has canceled claim 6. Accordingly, the rejection of claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Zenhausern in view of Nikiforov is moot.

In view of the above, Applicant respectfully requests withdrawal of the rejection of claims 1, 3, 4, 6, and 7 under 35 U.S.C. § 103(a) as being unpatentable over Zenhausern in view of Nikiforov.

**II. Rejection of claims 8-12 under 35 U.S.C. § 103(a) as being unpatentable over Zenhausern in view of Nikiforov and further in view of Lough**

Applicant respectfully traverses the rejection of claims 8-12 under 35 U.S.C. § 103(a) as being unpatentable over Zenhausern in view of Nikiforov and further in view of Lough.

Claims 8-12 depend from claim 1 and require all the elements of claim 1. As discussed above, Zenhausern and Nikiforov, alone or combined, fail to teach or suggest a microchip, “wherein, when the microchip is in use, the gap part is configured to block microbeads of a size greater than the sectional size of the gap part,” as recited in amended claim 1 and required by claims 8-12. Lough fails to cure the deficiencies of Zenhausern and Nikiforov. Accordingly, claims 8-12 are distinguishable over Zenhausern, Nikiforov, and Lough.

In view of the above, Applicant respectfully requests withdrawal of the rejection of claims 8-12 under 35 U.S.C. § 103(a) as being unpatentable over Zenhausern in view of Nikiforov and further in view of Lough.

**III. Rejection of claim 8-13 under 35 U.S.C. § 103(a) as being unpatentable over Zenhausern in view of Nikiforov and further in view of Lough and Smith**

Applicant respectfully traverses the rejection of claims 8-13 under 35 U.S.C. § 103(a) as being unpatentable over Zenhausern in view of Nikiforov and further in view of Lough and Smith.

Claims 8-13 depend from claim 1 and require all the elements of claim 1. As discussed above, Zenhausern, Nikiforov, and Lough, alone or combined, fail to teach or suggest a microchip, "wherein, when the microchip is in use, the gap part is configured to block microbeads of a size greater than the sectional size of the gap part," as recited in amended claim 1 and required by claims 8-13. Smith fails to cure the deficiencies of Zenhausern, Nikiforov, and Lough. Accordingly, claims 8-13 are distinguishable over Zenhausern, Nikiforov, Lough, and Smith.

In view of the above, Applicant respectfully requests withdrawal of the rejection of claims 8-13 under 35 U.S.C. § 103(a) as being unpatentable over Zenhausern in view of Nikiforov and further in view of Lough and Smith.

#### **IV. Conclusion**

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extension of time required to enter this Amendment and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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